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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,027	01/20/2004	Heike Lerg	100718-392/ Beiersdorf 48	1877

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EXAMINER

HARDEE, JOHN R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/761,027	Applicant(s) LERG ET AL.	
	Examiner John R. Hardee	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/053,342.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01202004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. The disclosure is objected to because of the following informalities: The Brief Description of the Drawing section is missing.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. The term "carbomer" refers to crosslinked acrylic acid homopolymers. While applicant may define the term otherwise, it does not appear that applicant had this alternative definition in possession at the time of filing.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Applicant has recited the presence of "an effective amount" of each of two constituents. Effective to do what?

6. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "carbomer" in claim 4 is used by the claim to mean "acrylate/alkyl acrylate copolymers", while the accepted meaning is "crosslinked acrylic acid homopolymers". The term is indefinite because the specification does not clearly redefine the term. In addition, the y subscript is missing.

Double Patenting

7. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,706,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a method of cleaning using a composition which has the same percentage amounts of the same composition presently claimed. Accordingly, it would have been obvious at the time the invention was made to make the claimed composition in order to use it as in the patented claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klueppel et al., US 5,145,665. Patentees disclose preparations for dental and oral hygiene. These compositions contain alkyl glycosides (abstract). Said glycosides may have a degree of oligomerization of 1. The alkyl group is derived from a primary alcohol of 8-22 carbons (col. 2, lines 11-32). The glycoside is present at 0.1-5% by weight (col. 2, lines 52-54). Humectants may be added to the compositions, including water-soluble

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Carbopols. Examiner takes the position that this teaching embraces crosslinked materials. No specific concentration of polymer is disclosed, but 0.40-1.5% of polymer is exemplified in the formulation examples. Exemplification of a gel tooth cream makes obvious the formulation of gels. Addition of polishing substances (solids) and liquids such as flavorings and water is disclosed at col. 3, lines 9-19 and is exemplified. Addition of 5-15% of glycerol is disclosed at col. 3, lines 48-49. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because patentees teach that all of the components claimed by applicant are suitable for inclusion in a tooth-cleaning composition. Regarding the recitation of copolymers, examiner maintains the position that the teaching in the reference of "carboxyvinyl polymers" may be fairly construed to embrace carboxyvinyl copolymers in view of the teaching of the utility of the Carbopol polymers as a class, which includes copolymers. Applicant discloses at p. 7, lines 23-25 of the specification that the Carbopols include acrylate-alkyl acrylate copolymers.

12. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giret et al., US 5,409,640. The reference discloses personal cleansing products. Said compositions preferably contain a polymeric skin or hair conditioning agent. Among the anionic polymers taught as useful are the Carbopols (col. 8, lines 12-20). Amounts of anionic polymer are not disclosed, but examiner takes the position that amounts at the low end of applicant's recited range are customary in the art, and therefore obvious.

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Compositions further comprise 0.1-20% of a nonionic or betaine surfactant. Among the nonionics disclosed as suitable are alkyl polysaccharides bearing an alkyl group of 8-18 carbons. Alkyl monosaccharide is preferably present as well at 20-70% of the total saccharide content (col. 6, lines 42-46). Inclusion of about 3% to about 40% of moisturizers, including glycerol and propylene glycol, is disclosed at col. 8, lines 43-44. Glycerol is highly preferred. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation. It would have been obvious at the time the invention was made to make such a composition, because the reference teaches that all of the components claimed by applicant are suitable for inclusion in a personal care composition.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Hardee", with a stylized, cursive script.

John R. Hardee
Primary Examiner
August 15, 2004